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2-Step tree
7-29-03

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By Kimberly A. Kears

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)
Jannette Stetson-Buck)
Serial No. 10/067,316)
Filed: 11/19/2001)
For: Method and apparatus)
for French Manicures)

Examiner: Christopher W. Fulton
Art Unit: 2859

REPLY TO FIRST OFFICE ACTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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Dear Commissioner:

In response to the Office Action mailed March 13, 2003, Applicant Jannette Stetson-Buck ("Applicant") respectfully submits the following reply:

I.

Summary of Examiner's Action

In the Office Action, the Examiner noted that claims 1-20 are pending in the application and that claims 1-5 are rejected, claims 15-20 are allowed and claim 14 is objected to as being dependent upon a rejected base claim. The Examiner notes that claim 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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II.

Informalities

The Examiner has objected to the drawings because the Examiner correctly observed that figures 8 and 9 are inconsistent. In response to this objection, the Applicant submits herewith a replacement sheet of drawings which corrects the inconsistency. Applicant represents that the replacement drawings contain no new matter.

III.

Claim Rejections - 35 USC § 102(b)

A. Claims 1 and 7-13 - Summary of Examiner's Grounds for Rejection

The Examiner rejected claims 1 and 7-13 under 35 U.S.C. 102 as being anticipated by Rossetter (United States Patent No. 1,115,337). The Examiner states that Rossetter discloses a device with a shank 10 having a proximal end and a distal end, a first circular blade on the outer side of 24, a second circular blade on the inner side of 24, and a gauging hyperboloid shaped stop 24 of a smaller size than the two circular blades.

B. Applicants' Reply to Examiner's Rejections

Anticipation requires that "[t]here must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic & Research Found. v. Genentech Inc.* (Fed. Cir. 1991) 18 USPQ 2d 1001, 1010. "Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindermann Maschinenfabrik GMBH v. American Hoist and Derrick Co.* (Fed. Cir. 1984) 221 USPQ 481, 485. There must be "corresponding elements disclosed in the allegedly anticipating reference." *Lindermann*, 221 USPQ at 485. In this case, there are claimed elements of the Applicant's invention which are not disclosed in the cited reference.

Every claim of the Applicant's application includes as an element "a gauging segment defined by the distance along the shank between the first blade and the second blade, wherein the gauging segment may be used to determine the length of a french manicure." (See the independent claims at 1(d), 9(d), 10(d), 15(b)(4), and 18(b)(4) and the associated dependent claims). According to the specification at page 5, line 30 through page 6, line 1:

A gauging segment 38 is defined by the distance between the first blade 34 and the second blade 36. The gauging segment 38 is that portion of the invention which is used to determine the length of a French manicure.

As further disclosed in the specification, first blade 34 and second blade 36 scribe marks on an artificial nail enhancement, which the manicurist uses in determining where to apply a first color and a second color to the nail. (Specification at 7, lines 10-20.) By providing a defined

1 length, the gauging segment thereby provides the respective boundary lines for each of the
2 colors. The specification further discloses that "a gauging segment length 38 between and
3 including one-fourth inch and one-half inch provides a visually appealing manicure."
(Specification at page 7, lines 6-7.)

4 The Examiner apparently takes the position that part 24, which the Examiner identifies as
5 "a gauging hyperboloid shaped stop," anticipates the gauging segment disclosed within the
6 application. However, Rossetter does not describe part 24 using the same terms as the
7 Examiner, but rather describes part 24 as a "peripheral concave abrasive surface." (Column 2,
8 lines 82-83) Rossetter never makes any reference to using part 24 as a gauge or means of
9 making a measurement. In fact, the Rossetter patent does not even contain the words "gauge",
"gauging", or "measure."

10 It is also clear from Rossetter's description that part 24 provides intentional or
unintentional gauging or measuring function. Rossetter states that his device is used as follows:

11 When it is desired to trim the nails, the device is attached to the motor (not
12 shown) and the enlarged portion of handle 5 is grasped with one hand, while the
13 circular guide 7 is inserted beneath of the nails of the other hand to bring the
14 abrasive periphery 24 or the rotary member 20 into engagement with the exposed
edge of the nail which latter is then trimmed to the desire shape by passing the
member 20 back and forth around the exposed edge of the nail.

15 (Col. 2:103 through Col. 3:4.)

16 Therefore, rather than being used as a gauge or measuring device, the abrasive periphery
17 is used for trimming the nails. Moreover, Rossetter does not disclose, nor is it apparent from the
18 drawings, that member 20 is bounded by blades or other surfaces which are capable of scribing
lines in the surface of a person's nails.

19 The Applicant respectfully submits that Rossetter fails to disclose every element of the
20 device claimed by the Applicant, and therefore the rejection under 35 U.S.C. 102(b) is not well
21 taken.

22 IV.

23 Claim Rejections - 35 USC § 103

24 A. Claims 2-6 - Summary of Examiner's Grounds for Rejection

25 The Examiner rejects claims 2-6 under 35 USC 103(a) as being unpatentable over
26 Rossetter. The Examiner notes that while Rossetter does not specifically disclose the specific
27 sizes of the various items claimed, it would have been obvious to one of ordinary skill in the art
at the time the invention was made to make the device of Rossetter any desired size.

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1 **B. Applicants' Reply to Examiner's Rejections**

2 For the reasons stated above, Applicant submits that her apparatus is not anticipated by
3 Rossetter, and therefore making the device of Rossetter in any desired size would not result in
4 the apparatus claimed by the Applicant.

5 **V.**

6 **Claim Rejections - 35 USC § 103**

7 **A. Claims 1-12 - Summary of Examiner's Grounds for Rejection**

8 The Examiner rejects claims 1-12 under 35 USC 103(a) as being unpatentable over
9 House (United States Patent No. D273,194). The Examiner submits that the claimed apparatus is
substantially disclosed by House and it would have been obvious to one skilled in the art at the
time the invention was made to make the device of House.

10 **B. Applicants' Reply to Examiner's Rejections**

11 House discloses the design of a "tool for cutting the inside of plastic pipes." It almost
12 goes without saying that the design patent of House does not provide any suggestion or
13 motivation that his tool be used in any way for performing manicures, or any other function
14 related to human grooming or hygiene. Applicant respectfully submits that the device disclosed
15 by House is not analogous art for purposes of a rejection under 35 USC 103(a). As stated in
MPEP 2141.01(a):

16 The examiner must determine what is "analogous prior art" for the purpose
17 of analyzing the obviousness of the subject matter at issue. "In order to rely on a
18 reference as a basis for rejection of an applicant's invention, the reference must
19 either be in the field of applicant's endeavor or, if not, then be reasonably pertinent
20 to the particular problem with which the inventor was concerned." *In re Oetiker*,
21 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). See also *In re*
22 *Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986); *In re Clay*, 966 F.2d
23 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992) ("A reference is reasonably
24 pertinent if, even though it may be in a different field from that of the inventor's
endeavor, it is one which, because of the matter with which it deals, logically
would have commended itself to an inventor's attention in considering his
problem."); and *Wang Laboratories Inc. v. Toshiba Corp.*, 993 F.2d 858, 26
USPQ2d 1767 (Fed. Cir. 1993).

25 The first requirement, that the reference be in the field of endeavor of applicant's
26 endeavor, is clearly not met in this case. The Applicant has claimed a method and apparatus for
27 french manicures, and therefore in an entirely different field from House's pipe cutting tool.

1 The second requirement, that the reference be reasonably pertinent to the particular
2 problem with which the inventor was concerned, is also not satisfied. The problem identified by
3 the Applicant is that when a manicurist the dimensions for a French manicure, the process is
4 inexact and yields an unsatisfactory result. (Specification at page 3, lines 2-9.) The entire
5 function of Applicant's apparatus is to *scribe* lines in the surface of an artificial fingernail
6 enhancement which allows a uniform application of color to the nails. (Specification at page 6,
7 lines 19-21; page 7, lines 10-20.)

8 The House patent is clearly not pertinent to any problem addressed by the Applicant. As
9 indicated by the title of the House patent, and Figure 1 therein, the purpose of the device
10 disclosed by House is cut the inside of plastic pipe. Nothing within the House patent indicates
11 that device is in any way pertinent to obtaining a uniform manicure.

12 Applicant therefore submits that the Examiner cannot properly rely on House as a basis
13 for rejection of an applicant's invention


14 VI.

15 Conclusion

16 Applicant respectfully submits that this submission is fully responsive to the March 13,
17 2003 Office Action, and these claims are in condition for allowance. The issuance of a Notice of
18 Allowance at an early date is therefore requested.

19 If the Examiner believes a telephone conference would expedite prosecution of this
20 application, please telephone the undersigned at (661)395-1000.

21 Respectfully submitted,

22 By 
23 JAMES M. DUNCAN
24 Reg. No. 44,664
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